

Application No. 10/020,861

REMARKS

Claims 1-6, 9-10, and 12-25 are pending. By this Amendment, claim 25 is amended and no claims are added or canceled.

1. The amendments to claim 25 are presented hereinbelow (added subject matter underlined, deleted subject indicated by strikethrough).

25. (Currently Amended) A method of providing a curvature path to the latch tip of a latching mechanism of a wafer container having an enclosure with an open front and a door to close the open front, the enclosure having a recess proximate the open front, the door having an opening, the method comprising ~~the step of:~~ attaching a four-bar linkage within the door, the latch tip connected to the middle movable link of the four-bar linkage and extending through the door opening into the recess when the door is secured in the open front of the enclosure.

Support for the foregoing amendments to claim 25 can be found, e.g., in Figures 1 and 4, in column 3 beginning at lines 11, 34, and 48, and in column 4, beginning at lines 36 and 46.

Applicants submit that no new material has been added by the amendments to the pending claims.

2. Applicants note that the Office Action states that claims 5, 6, 9, 10, and 12-25 are pending. However, claims 1-4 were allowed in the 5 March 2004 Office Action and are also pending.

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3. Responsive to the statement in paragraph 1 of the Office Action, Applicants acknowledge that a statement addressing the loss or inaccessibility of the original patent must be provided before this reissue application is allowed.

Recapture

4. Claims 5, 6, 9, 10, and 12-25 are rejected under 35 U.S.C. § 251 as an improper recapture of broadened claimed subject matter asserted to be surrendered in the application for U.S. Patent 6,000,732.

4(a). Regarding pending claims 5, 12, 16, 18, 19, and 25, the rejection asserts that the

non-Final Office Action (Paper No. 13 [actually Paper No. 15]) rejected claims under 35 U.S.C. § 102(b) in view of U.S.P.N. 3,421,471 to Richter, including examiner's statement that claimed container door's "spaced walls" did not patentably define from the perpendicularly-arranged walls of the reference's container door and otherwise indicating claim limitations being anticipated by the prior art. In response to that rejection, the independent claim 9 [now claim 1 of U.S. Patent 6,000,732] was amended to include terminology of "and parallel" to further define the container walls' arrangement:

"a container door fitted in said container and comprising two walls, spaced apart from and parallel to each other".

Applicant's arguments filed with that amendment specifically indicate that Applicant relies on the new limitation in order to patentably define from the prior art; see page 4 of Applicant's response (Paper No. 15) filed June 25, 1999.

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4(b). With respect to claim 9 [now claim 1 of U.S. Patent 6,000,732] the rejection also states:

The claim was additionally amended at that time to specifically require that the claimed means for locking and unlocking the claimed container door was located between two end "parallel" walls:

"means for locking and unlocking said container door comprising locking elements provided within said container door between said two parallel walls and being displaceable into a moved - in end position and into a moved - out end position and, when moving out, penetrate into said recesses within the container walls".

Applicant's arguments filed with that amendment specifically indicate that Applicant relies on the new limitation in order to patentably define from the prior art: see page 4 of Applicant's response (Paper No. 15) filed June 25, 1999.

4(c). With respect to claim 9 [now claim 1 of U.S. Patent 6,000,732] the rejection further states:

The claim was additionally amended at that time to specifically require specific structural arrangement of claimed locking elements, plates, rotatable disc, and motor:

"every locking element being in the form of a projection from a plate which is directed parallel to the outwardly directed wall of said container door, wherein all plates share a common drive in form of a rotatable disc driven by a motor and acting in the locking and unlocking direction for connecting rods provided for

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displacing the plates, the plates being fixed in the moved - in end position and in the moved - out end position by said connecting rods".

Applicant's arguments filed with that amendment specifically indicate that Applicant relies on the new limitation in order to patentably define from the prior art: see page 4-5 of applicant's response (Paper No. 15) filed June 25, 1999.

4(d). With respect to claim 9 [now claim 1 of U.S. Patent 6,000,732] the rejection still further states:

The claim was additionally amended at that time to specifically require other structural features of the "means for providing a curved path" including particulars of that claimed element including its arrangement as regards each of the plurality of plate structures and couplers:

"said means for providing for providing a curved path further comprising structure to maintain in move every [locking element] parallel to an outwardly directed wall of said to parallel walls of the container door [and includes] by means of couplers, said couplers for every plate being [connected thereto which are] parallel to each other and [which are] rotatably [supported at the locking element] connected to said plate and also to said outwardly directed wall so that, as a result of the couplers, there is a predetermined distance between [the locking element] every plate and said outwardly directed wall in the moved - in state, which distance decreases during the outward movement until the locking element comes into contact with a contact surface in the recess against which the locking element is pressed in its moved - out end position".

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Applicant's arguments filed with that amendment specifically indicate that

Applicant relies on the new limitation in order to patentably define from the prior

art: see page 5 of Applicant's response (Paper No. 15) filed June 25, 1999

Applicants traverse this rejection, respectfully pointing out that reliance on a limitation added during prosecution to obtain allowance does not necessarily invoke the Recapture Rule. To this end, Applicants first respectfully refer to Ex Parte Eggert¹, a 2003 precedential opinion of the U.S. Board of Patent Appeals and Interferences. The main issue determined by Eggert was the definition of surrendered subject matter subject to the Recapture Rule.² In Eggert, the appealing examiner contended that "each and every limitation added to a claim or argued by an applicant during the prosecution of the original patent application" was required to be present in a claim by the Recapture Rule.³ However, the holding of Eggert was that subject matter present

¹ Ex parte Daniel M. Eggert and Frank Mikic (deceased), Slip Opinion (Paper No. 22), 67 USPQ2d 1718 (Bd. Pat. App. & Inter. May 29, 2003)(precedential).

² Ex parte Daniel M. Eggert and Frank Mikic (deceased), Slip Opinion (Paper No. 22), page 31, 67 USPQ2d 1718 (Bd. Pat. App. & Inter. May 29, 2003)(precedential) ("Accordingly, we decline to extract from the above-quoted language in Pannu a generalized rule that a reissue claim which omits a limitation relied upon during prosecution of the patent application is per se impermissible under the recapture rule, regardless of whether the claim has been materially narrowed in other respects compared to the surrendered subject matter. Rather, we consider that the proper inquiry requires a fact-specific analysis in each case to determine whether the patentee is attempting to recapture by reissue subject matter that was surrendered during the prosecution of the patent application.") (emphasis added).

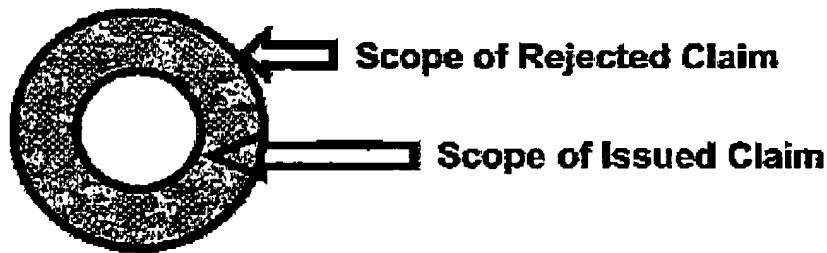
³ Ex parte Daniel M. Eggert and Frank Mikic (deceased), Slip Opinion (Paper No. 22), pages 19-20, 67 USPQ2d 1718 (Bd. Pat. App. & Inter. May 29, 2003)(precedential) ("The nature of the dispute appears to reside in the manner in which the surrendered subject matter is to be determined. The examiner contends that the recapture rule prohibits a patentee from obtaining in reissue any claim which does not include each and every limitation added to a claim or argued by an applicant during the prosecution of the original patent application in order to overcome a rejection and obtain a patent, citing Shepard v. Carrigan, 116 U.S. 593 (1886); In re Byers, 230 F.2d 451, 456-57, 109 USPQ 53, 57 (CCPA 1956)9 and Riley v. Broadway-Hale Stores, Inc., 217 F.2d 530, 532, 103 USPQ 414, 416 (9th Cir. 1954) as support for this proposition (request, page 10). This approach, while certainly relatively simple in its application, has been expressly

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in a claim was subject to the Recapture Rule only if the subject matter was present in the claim before the claim was amended into allowed form.⁴ That is, subject matter amended into the

rejected by the Court of Customs and Patent Appeals (CCPA) and the Court of Appeals for the Federal Circuit (Federal Circuit).").

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Drawing 1

Ex parte Daniel M. Eggert and Frank Mikic (deceased), Slip Opinion (Paper No. 22), pages 2-3, 67 USPQ2d 1718 (Bd. Pat. App. & Inter. May 29, 2003)(precedential) ("Prior to discussing the complex legal and technical issues involved in this appeal we believe it would be helpful to provide a summary of our decision and reasons in support. We shall make reference to Drawing 1 in doing so. There came a time in the prosecution of the '992 application that claim 1 (once amended) was presented for examination and was met by a final rejection from the examiner under 35 U.S.C. § 103. At that time, appellants were presented with a number of options for proceeding with the quest for patent protection. One was to appeal the examiner's final rejection of claim 1 (once amended) to this Board. Another was to concede that rejected claim 1 (once amended) was unpatentable and to amend that claim in an attempt to define narrower, patentable subject matter. Appellants chose the latter option and amended claim 1 a second time. Upon consideration of claim 1 (twice amended), the examiner determined that it was patentable. Thus, claim 1 (twice amended) became issued claim 1. The changing scope of a claim during the administrative examination process as it is amended to overcome prior art rejections can be viewed as a series of concentric circles. As illustrated in Drawing 1, the scope of rejected claim 1 (once amended) is the outer circle and the scope of amended issued claim 1 (twice amended) is the inner circle. The shaded area between the circles represents subject matter which is only narrower than the scope of the rejected claim but only broader than the scope of the issued claim. In our view, the surrendered subject matter is the outer circle of Drawing 1 because it is the subject matter appellants conceded was unpatentable. The subject matter of the shaded area was not subject to the administrative examination process as the examiner was never directly presented with a claim which fell within the scope of the shaded area. Thus, appellants have never conceded that a claim falling within the scope of the shaded area of Drawing 1 is unpatentable and therefore, in our view, such subject matter is not barred by the recapture rule." (emphasis added).

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claim such that the then amended claim was allowed is not subject to the Recapture Rule.^{5, 6, 7}

Thus, subject matter amended into a claim, the claim being subsequently allowed due to the specific amendment, is not surrendered and is not subject to the Recapture Rule.

Applicants next refer to the MPEP for support in Applicants' contention that the limitations cited in the rejection are not surrendered subject matter subject to the Recapture Rule. Section 1412.02 of the MPEP contains a comprehensive and involved discussion pertaining to the Recapture Rule. For example, MPEP section 1412.02(I)(B) states,

Where a claim in a reissue application is broadened in some respect as compared to the patent claims, the examiner must next determine whether the broadening

⁵ See also, Ex parte Daniel M. Eggert and Frank Mikic (deceased), Slip Opinion (Paper No. 22), page 13, 67 USPQ2d 1718 (Bd. Pat. App. & Inter. May 29, 2003)(precedential) ("In our view, focusing the starting point of a reissue recapture rule analysis on the claim that was amended to become the issued claim, i.e., the canceled, outer circle claim of Drawing 1, instead of the issued, inner circle claim of Drawing 1, itself will result in the corrected patent rights of a patentee being resolved more quickly and in a more public manner.").

⁶ Ex parte Daniel M. Eggert and Frank Mikic (deceased), Slip Opinion (Paper No. 22), pages 40-41, 67 USPQ2d 1718 (Bd. Pat. App. & Inter. May 29, 2003)(precedential) ("A review of the prosecution history outlined above reveals that appellants added the language 'said retaining member being generally bowl-shaped and convex toward said magnet' to claim 1 in response to the final rejection in order to overcome the prior art rejection based on Parsons in view of Clark and Miller. We thus conclude that appellants, in adding that limitation, conceded that claim 1 prior to that amendment was not patentable, thereby surrendering the subject matter of that claim. Hence, the omission of this limitation in reissue claims 15 and 22 is in an aspect germane to the prior art rejection. The deliberate amendment of claim 1 in an effort to overcome the prior art rejection is, in our view, an admission that the scope of the claim before the amendment is unpatentable and establishes that subject matter as surrendered subject matter.") (emphasis added).

⁷ Ex parte Daniel M. Eggert and Frank Mikic (deceased), Slip Opinion (Paper No. 22), pages 43-44, 67 USPQ2d 1718 (Bd. Pat. App. & Inter. May 29, 2003)(precedential) ("The prosecution history of the patent application in this case does not persuade us that appellants surrendered anything narrower than the subject matter of claim 1 prior to the amendment after final adding the limitation 'said retaining member being generally bowl-shaped and convex toward said magnet.' See *Festo*, 122 S.Ct. at 1838, 62 USPQ2d at 1711 (a patentee's decision to forego an

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aspect(s) of that reissue claim relate(s) to subject matter that applicant previously surrendered during the prosecution of the original application (which became the patent to be reissued).

Section 1412.02 then proceeds to support Applicants' contention that the subject matter at issue was not surrendered and is not subject to the Recapture Rule because this subject matter was amended into the rejected independent claims just before they were allowed. The foregoing portion of the MPEP states that claim limitations in broader form than those issued are not properly rejected under the Recapture Rule, thus supporting Applicants' contention that broader forms of limitations added/argued to overcome an art rejection may not necessarily be rejected under the Recapture Rule.⁸ To this end, it is Applicants' belief that all of the limitations at issue above were amended into claim 9 of the application in Paper No. 15, wherein claim 9 was then allowed. It is also Applicants' belief that all limitations present in claim 1 of U.S. Patent 6,000,732 (claim 9 as prosecuted) - albeit in arguably broader form in some of the pending claims - are present in the pending independent claims.

appeal and submit an amended claim is taken as a concession that the invention as patented does not reach as far as the original claim).").

⁸ MPEP § 1412.02(I)(C) (page 14-20) (8th Ed., Rev. 3 August 2005) ("Second, it must be determined whether the reissue claim entirely omits any limitation that was added/ argued during the original prosecution to overcome an art rejection. Such an omission in a reissue claim, even if it includes other limitations making the reissue claim narrower than the patent claim in other aspects, is impermissible recapture. Pannu v. Storz Instruments Inc., *supra*. However, if the reissue claim recites a broader form of the key limitation added/argued during original prosecution to overcome an art rejection (and therefore not entirely removing that key limitation), then the reissue claim may not be rejected under the recapture doctrine. Ex Parte Eggert, 67 USPQ2d 1716 (Bd. Pat. App. & Inter. 2003) (precedential). For example, if the key limitation added to overcome an art rejection was 'an orange peel,' and the reissue claim instead recites 'a citrus fruit peel', the reissue claim may not be rejected on recapture grounds.") (emphasis in original).

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To summarize, all limitations from issued claims must be present in reissue claims; however, the limitations may be present in broadened form. These broadened limitations are not subject to the Recapture Rule if they were amended into the claim in the manner described above.

During the prosecution of U.S. Patent 6,000,732, claim 9 (claim 1 in the issued patent) was amended in Paper No. 15, filed 21 June 1999, as asserted in the Office Action. The amendments to, and arguments supporting the patentability of, claim 9 in Paper No. 15 included each and every claim limitation cited above in the Office Action as a basis for rejection under the Recapture Rule. In making these amendments, Applicants arguendo may have conceded that the subject matter of claim 9, before being amended into allowable form, was not patentable. However, the subject matter amended into the allowable form of claim 9 in Paper No. 15 was not conceded as essential for patentability and thus, is not subject to the Recapture Rule.

Specifically:

The limitation discussed above at 4a was indeed present in the amendment in Paper No. 15, wherein "a container door fitted in said container and comprising two walls, spaced apart from and parallel to each other" was amended into claim 9.

The limitation discussed above at 4b was also present as an amendment in Paper No. 15, wherein

means for locking and unlocking said container door comprising locking elements provided within said container door between said two parallel walls and being displaceable into a moved - in end position and into a moved - out end position and, when moving out, penetrate into said recesses within the container walls

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was amended into claim 9.

The limitation discussed above that 4c was also present as an amendment in Paper No. 15, in which

every locking element being in the form of a projection from a plate which is directed parallel to the outwardly directed wall of said container door, wherein all plates share a common drive in form of a rotatable disc driven by a motor and acting in the locking and unlocking direction for connecting rods provided for displacing the plates, the plates being fixed in the moved - in end position and in the moved - out end position by said connecting rods

was amended into claim 9.

The limitation discussed above at 4d was also present as an amendment in Paper No. 15, wherein

said means for providing for providing a curved path further comprising structure to maintain in move every [locking element] parallel to an outwardly directed wall of said to parallel walls of the container door [and includes] by means of couplers, said couplers for every plate being [connected thereto which are] parallel to each other and [which are] rotatably [supported at the locking element] connected to said plate and also to said outwardly directed wall so that, as a result of the couplers, there is a predetermined distance between [the locking element] every plate and said outwardly directed wall in the moved - in state, which distance decreases during the outward movement until the locking element comes

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into contact with a contact surface in the recess against which the locking element is pressed in its moved - out end position was amended into claim 9 as well.

Each of the foregoing claim amendments cited to support the Recapture Rule rejection in the Office Action was present in the amendment which amended claim 9 into the form allowed. Hence, Applicants had not surrendered this subject matter as unpatentable. Therefore, none of the foregoing claim limitations cited in support of the rejection are subject to the Recapture Rule. Because none of the foregoing claim limitations can be properly cited to support the Recapture Rule rejection, reconsideration and withdrawal of the rejection are respectfully requested.

For reasons stated herein, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,


Wm. Larry Alexander, Ph.D.
Registration No. 37,269

Customer No. 24113
Patterson, Thuent, Skaar & Christensen, P.A.
4800 IDS Center
80 South 8th Street
Minneapolis, Minnesota 55402-2100
Telephone: (612) 349-5757